

REMARKS

In the Office Action dated December 9, 2003, claims 28-42 and 76-80 were rejected under 35 U.S.C. § 112, ¶ 2; claim 41 was objected to; claims 1-9, 28-31, 33, 39, 42, 62-64, 74, 76, and 81 were rejected under § 102 over U.S. Publication No. 2001/0052426 (Mercer); claims 32 and 65 were rejected under § 103 over Mercer in view of U.S. Publication No. 2003/0001753 (Cernocky); and claims 34-38, 40, 75, 77, and 78 were rejected under § 103 over Mercer in view of U.S. Patent No. 5,923,757 (Hocker).

Applicant acknowledges the indication that claims 66-73, 79, 80, 82, and 83 would be allowable if formal objections were overcome. Claims 66, 71, and 73 have been amended into independent form to place those claims in condition for allowance, as indicated by the Office Action.

To address the antecedent basis rejection, claims 29, 33, 34, 40, 41, and 42 (all now in independent form) have been amended to introduce the clause "the control module communicating with a tool" before the clause "the tool selected from the group. . . ." The scope of each of these claims remains *unchanged* by this amendment.

Claim 41 has been amended from dependent form to independent form, with the scope of the claim remaining *unchanged*. Claim 41 was objected to by the Office Action as not being supported by the specification. Applicant respectfully disagrees. Support for claim 41 can be found at least in paragraph [0093] on page 19 of the specification. Withdrawal of the objection is respectfully requested. Also, Applicant notes that no prior art rejection has been asserted against claim 41. Therefore, allowance of claim 41 is respectfully requested.

Claim 1 has been cancelled to render the rejection of that claim moot. Claim 3 has been amended from dependent form to independent form, with the elements of base claims 1 and 2 incorporated into claim 3. The scope of claim 3 remains *unchanged*. Claim 3 recites that the portable user interface device has a display to display a graphical user interface, where the graphical user interface includes one or more graphical elements *selectable to control the tool*. Although Mercer discloses a display 150 in its portable locator/controller 140, the display 150 of the locator/controller 140 is to display the status of the associated tool. There is no indication in

Mercer that the display 150 includes a graphical user interface that has one or more graphical elements selectable to control the tool. Therefore, claim 3 is not anticipated by Mercer.

Claim 6 has been amended from dependent form to independent form, with the scope of claim 6 remaining *unchanged*. Claim 6 recites that the control module is adapted to send a command to the tool to perform a test of the tool. There is no indication in Mercer that its control console 104 is able to send a command to the boring tool 90 for testing the boring tool. Moreover, with respect to claim 7, which depends from claim 6, there is no indication whatsoever in Mercer of displaying a result of the test. Nor is there any disclosure in Mercer, with respect to claim 8, of a tool including plural control units, where the user interface device is able to send commands to the tool to successively test the plural control units.

Independent claim 28 has been cancelled to render the rejection of that claim moot. Claim 29 has been amended from dependent form to independent form, with the scope of the claim remaining *unchanged*. Mercer does not disclose accepting *user selection* of an item in a *graphical user interface* of the portable user interface device to perform a task associated with the tool. The display 150 of Mercer does not include an item that is selectable by a user. Therefore, claim 29 is not anticipated by Mercer.

Claim 33 has been amended from dependent form to independent form, with the scope of the claim remaining *unchanged*. As noted above, Mercer does not disclose sending a command to test the tool.

Claim 42 has been amended from dependent form to independent form, with the scope of the claim remaining *unchanged*. Mercer does not disclose a core sampling tool, or a method that includes an act of storing information collected by the core sampling tool in the user interface device. Mercer describes a boring tool--however, no discussion is made in Mercer that the boring tool is able to perform core sampling. Therefore, claim 42 is not anticipated by Mercer.

Claims 34 and 40 have both been changed from dependent form to independent form, with the scope of each claim remaining *unchanged*. Claims 34 and 40 were rejected as being obvious over Mercer and Hocker. Applicant respectfully disagrees.

Claim 34 recites receiving identifiers of components for use in a tool, where the tool is capable of communicating with a control module that in turn wirelessly communicates with a portable user interface device. The Office Action stated that Mercer is "silent about his interface device receiving data from a scanner module." 12/9/03 Office Action at 3. The Office Action

then cited to Hocker as teaching a portable device receiving data from a scanner module. *Id.* However, no mention is made by the Office Action of how either Mercer or Hocker teaches receiving identifiers of components for use in the tool, as recited in claim 34. For at least this reason, a *prima facie* case of obviousness has not been established with respect to claim 34.

Moreover, Applicant notes that Hocker does not teach or suggest receiving identifiers of components for using a tool in the context of claim 34. Hocker relates to a docking method where an input device, such as a mouse, can securely perform wireless communication with a computer (14). When the input device enters a predefined docking area 32 (as shown in Figure 2), identifying information is exchanged between the input device and the computer. Hocker, 5:32-60. However, Hocker does not provide any teaching or suggestion that identifiers of components of a tool are received. Therefore, even if they can be properly combined, the hypothetical combination of Mercer and Hocker does not teach or suggest each and every element of claim 34.

Moreover, with respect to claim 77, which depends from claim 34, there is no teaching within Mercer or Hocker of storing information pertaining to *inventory components* and updating information based on usage.

Claim 40 recites providing a security feature in a user interface device to prevent unauthorized access of the user interface device, where the security feature comprises one of a field to accept a password and a component to interact with a smart card. Hocker neither discusses a security feature that has a field to accept a password nor a component to interact with a smart card. Therefore, the hypothetical combination of Mercer and Hocker does not teach or suggest the invention of claim 40. A *prima facie* case of obviousness has thus not been established with respect to claim 40.

In view of the foregoing, it is respectfully submitted that all claims are in condition for allowance, which action is respectfully requested. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0187US).

Appl. No. 09/997,021
Amdt. dated February 9, 2004
Reply to Office Action of December 9, 2003

Date: February 9, 2004

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Dan C. Hu', is written over a horizontal line.

Dan C. Hu, Reg. No. 40,025
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
713/468-8880 [Ph]
713/468-8883 [Fax]